

REMARKS

In the Office Action, claims 21-22 stand rejected under 35 U.S.C. § 112, claims 20-21 stand rejected under 35 U.S.C. § 102 and claim 23 stands rejected under 35 U.S.C. § 103. Applicants have restored claim 21 and amended claims 20-22. Applicants respectfully traverse the §102 and §103 rejections and request reconsideration in view of the foregoing amendments and following remarks. Upon entry of this Amendment, claims 21-22 will be pending in the application.

Claim Rejections Under 35 U.S.C. § 112

In the Office Action, claim 21 is rejected because of certain missing text. Applicants have restored the full original text of claim 21 and have further amended claim 21 to ensure a proper antecedent basis for the claim. Claim 22 is rejected for lack of proper antecedent. Applicants have amended claim 22 to replace “excitation and emission” with “input and output” before the word “mirrors.” Applicants respectfully submit that the claim amendments eliminate the grounds of the rejections. Applicants therefore request withdrawal of the rejections.

Claim Rejections Under 35 U.S.C. § 102

In the Office Action, claims 20 and 21 stand rejected under 35 U.S.C. § 102 as being anticipated by U.S. Reissue Patent No. RE 32,598 to White (“White-RE”). Applicants respectfully traverse the rejection and respectfully submit that White-RE fails to teach each and every element of the claims as required to support a rejection under 35 U.S.C. § 102.

In particular, amended claim 20 requires an input mirror, positioned substantially coaxial with an area to be illuminated, for directing incoming light to illuminate the area; and an output mirror, positioned substantially coaxial with the area to be illuminated and in reflective alignment with the input mirror, for collecting focusing, and directing light emitted by the area upon illumination. Further, amended claim 21 requires that the output mirror is a spherical mirror White-RE does not teach *inter alia* the recited output mirror.

The Office Action cites mirrors 32 and 96 in White-RE as anticipating the output mirror of the present application. White-RE teaches that a “portion of the emitted fluorescence is collected by a spherical lens 33 and is directed thereby through a cylindrical lens 34 to a spherical off-axis mirror 35 and a flat off-axis mirror 36” (*see* col. 4, lines 40-44, emphasis added). Likewise, White-RE teaches “[f]luorescence from the sample 78 is

collected by a convex spherical lens 105 (FIG. 3) in the emission optical system for the instrument,” and the “fluorescent emission beam then passes through a lens 107 and is focused by a lens 108 on the entrance slit 109 of an emission monochromator 110” (col. 7, lines 8-13).

Therefore, it is apparent that the collecting, focusing and directing of light recited in claims 20 and 21 is not performed by White-RE’s mirrors 32, 96 as suggested in the Office Action but rather by White-RE’s lenses 33, 34, 107 and 108. White-RE explicitly assigns a different functionality to the mirrors as shown, for example, in the statement that: [t]o provide a further increase in the intensity of the light beam passing through the sample 25 ... mirror 32 directs the excitation beam back through the sample for a second pass” (col. 4, lines 30-36). It is apparent from this latter passage that mirror 32 is provided to provide illumination light rather than collect excitation light. Similarly, mirror 96 is for increasing excitation light intensity. White-RE’s pair of mirrors 95 and 96 are for reimaging exit slit images back on themselves to further increase the intensity of excitation light (*see* col. 6, line 37 – col. 7, line 7). Therefore, it is clear from these descriptions in White-RE that the cited mirrors do not teach the output mirror required in the claims of the present Application.

Applicants note that, even where White-RE teaches mirrors in the emission light collection path, such mirrors are ineffective in supporting a rejection of the claims under 35 U.S.C. § 102. Specifically, White-RE teaches “a spherical off-axis mirror 35 and a flat off-axis mirror 36” for directing light to emission monochromator 40 (*see* col. 4, lines 37-59). However, claim 20 requires an output mirror, positioned substantially coaxial with the area to be illuminated and White-RE’s mirrors 35 and 36 are explicitly off-axis mirrors. Therefore, not even White-RE’s mirrors 35 and 36 support a rejection of claims 20 and 21 under 35 U.S.C. § 102.

Consequently, Applicants submit that the rejections of claims 20 and 21 are improper because White-RE cannot be said to teach each and every element of the claims. Therefore, for at least these reasons, the rejections of claims 20 and 21 should be withdrawn.

Claim Rejections Under 35 U.S.C. § 103

In the Office Action, claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over White-RE in view of U.S. Patent No. 4,355,871 to Nevyas et al. (“Nevyas”). The Office Action recognizes that Nevyas does not teach input and output mirrors that are first-surface mirrors as required by claim 22. In view of the foregoing deficiencies of White-RE, Applicants respectfully submit that the claim rejections based upon

35 U.S.C. §103(a) are also improper because Nevvas does not cure all of the deficiencies of White-RE and, further, because an ordinarily skilled artisan would not have been motivated to combine White-RE with Nevvas in the manner suggested by the Examiner.

The combination of White-RE and Nevvas does not render obvious an input mirror, positioned substantially coaxial with an area to be illuminated, for directing incoming light to illuminate the area; and an output mirror, positioned substantially coaxial with the area to be illuminated and in reflective alignment with the input mirror, for collecting focusing, and directing light emitted by the area upon illumination, wherein both input and output mirrors are first surface mirrors as required by claim 22. Nevvas merely recites the benefits of coating one side of glass to form a mirror in some applications. Nevvas provides no teaching specific to the claims of the present Application and cannot be said to supply, for example, the output mirror required by claim 22.

Further, Nevvas is directed to optical beam splitting and rotating for the purpose of creating multiple images of an optical target for use in ophthalmic surgery. (*See* Nevvas Abstract). Nevvas provides no instruction regarding excitation, emission or fluorescent light. Nevvas is a dissimilar application and there would have been no motivation for one of ordinary skill in the art to look to the surgical device of Nevvas to resolve problems in the area of scanning spectrophotometers.

Applicants respectfully submit that Nevvas does not cure the deficiencies of White-RE and that there would have been motivation to combine White-RE with Nevvas. Therefore, for at least these reasons, rejection of claim 22 should be withdrawn.

The Additional Prior Art

Applicants note that U.S. Patent No. 4,099,872 to White ("White II") issued from a continuation-in-part of the Patent from which White-RE was reissued. Consequently, the teachings of White-RE and White II are similar and equally ineffective in supporting rejections of the claims under 35 U.S.C. § 102 or 35 U.S.C. § 103. Specifically, White II teaches that the cited mirror 93 merely serves as a retro mirror and functions to pass excitation light twice through the same volume of sample (*see* col. 9, lines 13-19). Therefore, Applicants respectfully submit that White II is cumulative and ineffective in supporting a rejection of the claims of the present Application.

Other Amendments


Applicants have amended claim 21 to correct a minor typographical error.

CONCLUSION

All objections and rejections having been addressed, and in view of the foregoing arguments, the claims are believed to be in form for allowance, and such action is earnestly solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to contact the undersigned at the telephone number listed below. Please charge any fees associated with the submission of this paper to Deposit Account Number 502212, referencing invoice number 016417-0305324. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

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